

1190, 1195 (Fed. Cir. 1993). However, if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant.

It is respectfully submitted that a person of ordinary skill in the art could interpret the rejected claims so as to understand how to avoid infringement. There is nothing ambiguous about the interpretation of the meaning of the claim: a balance request is determined to be ineligible when the institutions holding the respective credit accounts are related. Not specifying what happens when it is determined that they are unrelated is not necessary to enable interpretation to avoid infringement. Therefore, it is submitted that omissions of an "if 'no'" statement does not render the claims indefinite, and the claims meet the statutory requirements.

Applicants would consider making claim amendments to suggest improved language, if the examiner would like to make such suggestions.

Section 101 Rejection

It is respectfully submitted that claims 1-17 are directed to statutory subject matter. According to Section 2106 of the Manual for Patent Examination Procedure (8th ed. August, 2006),

For purposes of an eligibility analysis, a physical transformation "is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application." AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. If USPTO personnel determine that the claim does not entail the transformation of an article, then USPTO personnel shall review the claim to determine if it produces a useful, tangible, and concrete result. In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is "useful, tangible, and concrete."

It is respectfully submitted that a tangible, concrete and useful result is produced by the claimed process: a determination of whether a credit account at a financial institution is eligible for balance transfer to a second credit account at another financial institution. A physical act such as a transfer of funds is not a requirement.

Furthermore, claims 14-17 are literally directed to physical, tangible items, and are not directed to mathematical algorithms, laws of nature or merely abstract ideas.

Therefore, it is submitted that this rejection is in error for at least these reasons.

102(e) Rejection

The examiner contends that US Patent No. 6,267,292 B1 of Walker, et al. (“Walker”) discloses in figure 8A, at step 825, “determining if financial institution (of first credit account) is related to financial institution (of second credit account), and at step 830 in the same figure, “if true – identifying first credit account as being not eligible for a balance transfer to second credit account.” Applicants respectfully disagree.

Step 825 states “Issuing banks loop up credit card information of the transferor and the transferee.” Step 830 states “does incomplete transferor credit information provided match complete information?” Walker concerns generally one credit card holder (the “transferor”) making a payment to another credit card holder (the “transferee”) by debiting his credit card and crediting the transferee’s credit card. Col. 4, lines 23-26. Figure 8A is simply describing the steps of the credit card holder transferor (see col. 7, lines 59-61) providing instructions that include the credit card account information of the respective parties (col. 7, line 61, to col. 8, lines 4), the respective issuing banks looking up the complete credit card information of the respective transferor and transferee (step 825 of Fig. 8A), and validating it (steps 830 and 840 of Fig. 8A). See also Col. 8, lines 5-25.

In order to anticipate a claim, a single, prior art reference must contain each and every element set forth in the claim. Manual for Patent Examination Procedure, § 2131 (8th ed. August, 2006). Each of the claims 1-17, either expressly or by dependency, requires a determination be made as to whether the issuing banks are related, and that a determination of ineligibility be made if it is determined that they are related. Walker makes no mention of either of these determinations being made in Figure 8a. The only determinations that appear to be made by Walker is whether incomplete information provided by the transferor (e.g. last 6 digits of credit card number) matches complete information and the credit cards are valid. See col. 4, lines 33-36, and col. 8, lines 5-25. For at least these reasons, Walker cannot anticipate claims 1-17 and, therefore, the rejection is in error.

In view of the foregoing errors, remaining errors in the reasoning of the examiner are moot. Applicants’ failure to address these errors does not constitute acquiescence or waiver in

the examiner's reasoning. Applicants reserve the right to address these errors in later remarks or on appeal, if necessary.

CONCLUSION

In view of the remarks, applicants respectfully submit that the application is in allowable form. Accordingly, applicants respectfully request reconsideration and allowance of the currently pending claims.

Applicant hereby authorizes the Commissioner to charge any fees due but not submitted with this paper to Deposit Account No. 07-0153. The Examiner is respectfully requested to call Applicant's Attorney for any reasons that would advance the current application to issue. Please reference new Attorney Docket No. 132538-1016.

Dated: July 19, 2007

Respectfully submitted,
GARDERE WYNNE SEWELL LLP

/Marc A. Hubbard/
Marc A. Hubbard
Registration No. 32,506
ATTORNEY FOR APPLICANT

3000 Thanksgiving Tower
1601 Elm Street
Dallas, Texas 75201-4761
(214) 999-4880 - Telephone
(214) 999-3880 - Facsimile